

### **REMARKS**

Claims **13-18, 21-22, 24-26, 28-29, and 42-47** are pending in this application. According to the March 7, 2008 Office Action, claims **13-18, 21-22, 24-26, 28-29, and 42-47** are rejected.

Independent claims **13** and **42** have been amended, dependent claims **14-17, 21-22, 25-26, 28, and 43-46** have been amended, and new dependent claims **48-80** have been added to recite particular embodiments that Applicant, in Applicant's business judgment, has currently determined to be commercially desirable. In particular, independent claims **13** and **42** have been amended to be dependent claims, and dependent claims **14, 25, and 43** have been amended to be independent claims. Independent claim **24** and dependent claims **18, 29, and 47** have been canceled. The subject matter of the previously presented and canceled claims will be presented in one or more continuing applications.

Accordingly, the following claims are under consideration:

- Independent claims **14, 25, and 43**.
- Dependent claims **13, 15-17, 21-22, 26, 28, 42, 44-46, and 48-80**.

### **I. STATUS OF THE APPLICATION**

In the Office Action Summary (PTOL-326), the Examiner indicates that the Office Action is a non-final action and then at page 13 of the Office Action, indicates that the Office Action is a final action.

Because the Examiner:

- (i) indicates at paragraph 1, page 2 of the Office Action that "[i]n light of Applicant's arguments, the rejection of [the] claims ... are withdrawn and new grounds of rejection are established," and
- (ii) indicates at paragraph 24, page 13 of the Office Action that "Applicant's arguments filed 10/04/2007 have been fully considered but are moot in view of the new grounds of rejection,"

it appears that the indication at page 13 that the Office Action is a final action is a typographical error and that the Office Action is indeed a non-final action. Applicant will proceed as such.

## **II. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)**

At paragraphs 2-23, pages 2-13 of the Office Action, the Examiner rejects claims **13-18, 21-22, 24-26, 28-29, and 42-47** under 35 U.S.C. § 103(a) as being unpatentable over Pritchard, U.S. Patent Applicant Publication No. 2002/0046154 (hereinafter Pritchard) in view of Wolfberg et al., U.S. Patent No. 5,214,579 (hereinafter Wolfberg). The Examiner fails to establish a *prima facie* case of obviousness of any of the claims.

### **A. Pritchard does not preclude patentability under section 103**

35 U.S.C. § 103(c)(1) states in part:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, ... subject to an obligation of assignment to the same person.

(underline emphasis added).

Both Applicant's claimed invention and the subject matter of Pritchard were, at the time the claimed invention was made, subject to an obligation of assignment to the same entity, namely eSpeed, Inc. As such, Pritchard does not preclude patentability under section 103. Therefore, the Examiner fails to establish a *prima facie* case of obviousness of any of the claims.

### **B. The Examiner has not shown the cited portions of Pritchard and Wolfberg to disclose all limitations of the claims**

Previously presented claim **14** (and similarly claims **25** and **43**) recites in part:

*providing a notification when the rate of return deviates at a pre-determined ratio from the target rate of return.*

In rejecting these claims, the Examiner asserts that Pritchard paragraph [0018] discloses:

generate reports to investors and/or brokers on the value of the trust and its underlying investment instruments, on the present and expected return of the investment and other information.

(underline emphasis added by the Examiner).

The Examiner appears to equate the “present return of the investment” and the “expected return of the investment” to the “*rate of return*” and the “*target rate of return*” of claim **14** (and similarly claims **25** and **43**). Even assuming, *arguendo*, that the “present return of the investment” and the “expected return of the investment” are similar to the “*rate of return*” and the “*target rate of return*” of claim **14**, the Examiner makes no reference to a “*pre-determined ratio*” as recited by this claim and as such, fails to indicate how and/or where in paragraph [0018] Pritchard discloses such features of the claim. Accordingly, the Examiner fails to establish a *prima facie* case of obviousness of claim **14** (and similarly claims **25** and **43**).

Amended independent claim **14** (and similarly amended independent claims **25** and **43**) recites in part:

*determining that the rate of return of the at least one asset deviates from the pre-determined target rate of return by at least a pre-determined amount; and*

*based at least in part on determining that the rate of return of the at least one asset deviates from the pre-determined target rate of return by at least the pre-determined amount, providing to the user via the first computing device a notification of the deviation.*

For similar reasons discussed above, the Examiner has not shown Pritchard paragraph [0018] to disclose a “*pre-determined amount*” and as such, has not shown Pritchard paragraph [0018] to disclose the above noted limitations of claim **14** (and similarly claims **25** and **43**).

Referring to dependent claims **13, 15-17, 21-22, 26, 28, 42, and 44-46**, because these claims depend from independent claims **14, 25, and 43**, the cited portions of Pritchard and Wolfberg have not been shown to disclose all the limitations of these claims for at least the same reasons set forth above.

### **III. NEW CLAIMS**

Because new dependent claims **48-80** depend from independent claims **14, 25, and 43**, the cited portions of Pritchard and Wolfberg have not been shown to disclose all the limitations of these claims for at least the same reasons set forth above.

**IV. CONCLUSION**

In view of the remarks and amendments, we respectfully submit that the claims are in condition for allowance. We request that the application be passed to issue in due course. The Examiner is urged to telephone the undersigned representative at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Respectfully submitted,

September 8, 2008  
Date

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